

Remarks

Please cancel claims 55 to 70 and 120 to 130 without prejudice or disclaimer. Claims 131, 132, and 133 have been added. Claims 131, 132, and 133 are pending and under consideration.

Support for new claim 131 is found, e.g., at original claim 60 and pages 50 to 51. Support for new claim 132 is found, e.g., at Table 2, pages 65 to 66 in Example 1. Support for new claim 133 is found e.g., at page 49, where U.S. Patent No. 5,514,543 (the '543 patent) is incorporated by reference. Support for claim 133 is found, e.g., in the '543 patent at col. 22, lines 3-6.

Thus the claims are fully supported by the specification and add no new matter.

Rejection in View of Barany PCT

The Examiner rejected claims 52 to 64, 69 to 80, 85, 86, and 115 to 117 under 35 U.S.C. § 102(b) as allegedly being anticipated by WO 97/31256 (Barany PCT). See September Final Action at page 3. Applicant respectfully traverses the rejection. First, applicant incorporates herein by reference all of the remarks concerning this rejection presented to date, including remarks presented in the Amendment After Final that was filed December 11, 2002.

Second, the Examiner contended that claim 144 of Barany PCT teaches "a kit with probes (claim 138) . . . combined with amplification primers and a polymerase."

Advisory Action, page 2. In claim 144 of Barany PCT, however, the "amplification primers [are] suitable for **preliminary amplification of the target nucleotide**

sequences" Prior claim 60 recited a primer set comprising (i) at least one primer comprising the sequence of the 5' primer-specific portion of the first probe, and (ii) at

least one primer complementary to the 3' primer-specific portion of the second probe. Claim 144 of Barany PCT does not teach such a primer set. Thus, Barany PCT failed to teach or suggest prior claim 60.

In any event, claims 52 to 64, 69 to 80, 85, 86, and 115 to 117 have been canceled without prejudice or disclaimer. Thus, the Examiner's rejection is moot. Furthermore, Barany PCT fails to show all of the elements of new claims 131, 132, and 133.

Rejection in View of Barany US

The Examiner rejected claims 52 to 63, 69 to 79, 85, 86, 115 to 117, and 120 to 129 under 35 U.S.C. § 102(a) and (e) as allegedly being anticipated by US Patent No. 6,027,889 (Barany US). See September Final Action at page 5. The Examiner cites various text of Barany US as allegedly showing various aspects of certain claims. See *id.* at pages 5 to 6. Applicant respectfully traverses the rejection.

First, applicant incorporates herein by reference all of the remarks concerning this rejection presented to date, including remarks presented in the Amendment After Final that was filed December 11, 2002. Contrary to the contention of the Examiner in the Advisory Action, applicant has identified structural differences between the claims and Barany US.

In any event, claims 52 to 63, 69 to 79, 85, 86, 115 to 117, and 120 to 129 have been canceled without prejudice or disclaimer. Thus, the Examiner's rejection is moot. Furthermore, Barany US fails to show all of the elements of new claims 131, 132, and 133.

Applicant respectfully requests reconsideration and withdrawal of the § 102 rejection over Barany US.

Rejection in View of Barany PCT and Xu

The Examiner also rejected claims 52 to 86 and 115 to 129 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Barany PCT in view of Xu et al., Tetrahedron Lett., 38(32):5595-5598 (1997) (Xu). See September Final Action at page 7. The Examiner stated that Barany PCT "teaches the limitation of claims 52-64, 69-80, 85, 86 and 115-117 as discussed above." See *id.* The Examiner then stated that Barany PCT did not teach use of tosylated or iodate oligonucleotides for ligation. See *id.* The Examiner contended that Xu discussed tosylated and iodate oligonucleotides for ligation. See *id.* Applicant respectfully traverses.

Applicant incorporates herein by reference all of the remarks concerning this rejection presented to date, including remarks presented in the Amendment After Final that was filed December 11, 2002. Moreover, as noted above, the rejected claims have been canceled. Furthermore, Barany PCT and Xu fail to show all of the elements of new claims 131, 132, and 133.

Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection over Barany PCT and Xu.

Rejection in View of Barany PCT and Boyce-Jacino

The Examiner rejected claims 52 to 64, 69 to 80, 85, 86, 115 to 117, and 120 to 129 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Barany PCT in view of WO 99/66076 (Boyce-Jacino). See September Final Action at page 8. The

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Examiner notes that he cites Boyce-Jacino as allegedly teaching a primer-specific portion to be used with the probe of Barany PCT if the anticipation rejection that relies upon the alleged inherency of such a primer-specific portion is reversed. *See id.*

Applicant incorporates herein by reference all of the remarks concerning this rejection presented to date, including remarks presented in the Amendment After Final that was filed December 11, 2002. Moreover, as noted above, the rejected claims have been canceled. Furthermore, Barany PCT and Boyce-Jacino fail to show all of the elements of new claims 131, 132, and 133.

Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection over Barany PCT and Boyce-Jacino.

Rejection in View of Barany PCT, Boyce-Jacino, and Xu

The Examiner also rejected claims 52 to 86 and 115 to 129 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Barany PCT, in view of Boyce-Jacino, and further in view of Xu et al., Tetrahedron Lett., 38(32):5595-5598 (1997) (Xu). *See* September Final Action at page 11. The Examiner cited Barany PCT and Boyce-Jacino for the reasons discussed in the prior rejection and stated that Barany PCT and Boyce-Jacino did not teach use of tosylated or iodate oligonucleotides for ligation. *See id.* The Examiner contended that Xu discussed tosylated and iodate oligonucleotides for ligation. *See id.* Applicant respectfully traverses.

Applicant incorporates herein by reference all of the remarks concerning this rejection presented to date, including remarks presented in the Amendment After Final that was filed December 11, 2002. Moreover, as noted above, the rejected claims have

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been canceled. Furthermore, Barany PCT, Boyce-Jacino, and Xu fail to show all of the elements of new claims 131, 132, and 133.

Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection over Barany PCT, Boyce-Jacino, and Xu.

Conclusion

Applicant respectfully asserts that the application is in condition for allowance and requests issuance of a Notice of Allowance. If the Examiner does not consider the application to be in condition for allowance, applicant requests that he call the undersigned at (650) 849-6620 to set up an interview.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.



By: _____

M. Paul Barker
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Dated: September 11, 2003

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